

REMARKS

Claims 1-21 and 30-58 are pending in this application. Claims 1, 8, 17 and 30 have been amended. Claims 51-58 are new. Claims 1, 30 and 34 are the independent claims. Claims. Currently, the Office has rejected Claims 30, 34, 38, 46, 49 and 50 under 35 U.S.C. § 102(b) and Claims 1-21, 31-33, 35-37, 39-45, 47 and 48 under 35 U.S.C. § 103(a).

Arguments in view of the 35 U.S.C. § 102(b) Rejection of Claim 30

The Office has rejected Claim 30 as being anticipated by Atake (U.S. Patent No. 6,325,607) under 35 U.S.C. § 102(b). Without conceding the propriety of the Office's rejection, Claim 30 has been amended to include, in part, "a heat shield assembly adapted to selectively interpose a heat shield, simultaneously, between each contact surface and the strip when the process is paused". The Office says that Atake teaches a heat shield 85 in Figure 8 and at Col. 10, Lines 55-65. However, Atake only teaches a single heat shield 85. Applicant's Claim 30 requires two heat shields (i.e. one heat shield placed between each contact surface and the strip). Further, Claim 30 has been amended to require that each heat shield is inserted simultaneously with respect to one another. Neither Atake nor any of the other cited references teach the claimed apparatus capable of simultaneously placing one heat shield between each contact surface and the strip. Accordingly, Applicant respectfully requests withdrawal of the rejection of Claim 30 and its dependent claims.

Arguments in view of the 35 U.S.C. § 102(b) Rejection of Claim 34

The Office has rejected Claims 34, 38, 46, 49 and 50 as being anticipated by Atake (U.S. Patent No. 6,325,607) under 35 U.S.C § 102(b). Claim 34, as currently written is in means-plus-function format and invokes 35 U.S.C. § 112, ¶ 6. Applicant traverses this rejection.

MPEP § 2181 sets forth the guidelines, or 3-part test, for recognizing the 35 U.S.C. § 112, ¶ 6 limitations: a) the claim limitations must use the phrase “means for” or “step for”; b) the “means for” or “step for” must be modified by functional language; and c) the phrase “means for” or “step for” must not be modified by sufficient structure, material, or acts for achieving the specified function. Although Applicant submits that several limitations of Claim 34 require interpretation under 35 U.S.C. § 112, ¶ 6, Applicant brings to the Office’s attention only the following limitation at Line 3 of Claim 34: “means for positioning and guiding the strip in the apparatus”. This limitation has “means for”; functional language – “positioning and guiding the strip in the apparatus”; and the “means for” is not modified by any structure that achieves the specified function. According, this claim is to be interpreted under 35 U.S.C. § 112, ¶ 6.

Applicant submits that the Office has not set forth that Atake discloses the means for guiding and positioning the strip as disclosed in Applicant’s specification nor sets forth a prima facie case of Equivalence. The means for guiding and positioning the strip is described on at least Page 10 at Lines 11-17. The “[s]heet guide 39 is mounted transversely in upper housing 50, and includes a lower guide plate 51a and an upper guide plate 51b secured together with fasteners”. The office has stated that the limitation “means for positioning and guiding the strip in the apparatus” is anticipated by the

reference numeral 50 in figure 2 of Atake. Reference # 50 in Atake is “a pair of endless loop chains”. (See Col. 5, Line 13).

Even if the prior art reference teaches the identity of function of that specified in the claim limitation, the Office has the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material or acts described in the specification. (See MPEP 2182). Applicant’s disclosure discloses the means for positioning and guiding the strip as two plates fastened together, which may imply that the plates are stationary. The Examiner has failed to set forth the recited function of the claim limitation and whether or not Atake achieves that function. Further, the endless-loop chains of Atake clearly do not anticipate the specific structure disclosed by Applicant. As the endless-loop chains move and are not stationary, they are clearly not equivalent structures, materials or acts to that which Applicant discloses in the specification for the means for positioning and guiding.

Thus, the Office has failed to show that Atake anticipates the “means for positioning and guiding” limitation of Claim 34 and its dependent claims. In addition, none of the cited references cure this deficiency. Therefore, Applicant respectfully requests that the Office withdraw this rejection. Further, in the event the next Office Action rejects Claims 34-50, such Action must be non-final as the burden has not yet shifted to Applicant to rebut a prima facie case of anticipation or non-obviousness with respect to the submitted claims.

Arguments in view of the 35 U.S.C. § 103(a) Rejection of Claim 1

The Office has rejected Claims 1, 10-12 and 15-16 under 35 U.S.C. § 103(a) as being unpatentable over Atake, in view of Fuji (5,571,473) and further in view of Mutti, et

al. (4,778,372). Without conceding the propriety of the rejection, Applicant has amended Claim 1 to include, in part, "a stationary guide structure for positioning and guiding the strip in the apparatus". The Office states that Atake teaches a guide structure at Reference # 50, Figure 2. Reference # 2 of Atake represents an endless-loop chain as seen at Col. 5, Line 13. The endless-loop chain 50 of Atake is clearly not a **stationary** guide structure and neither Atake nor any cited references has or teaches or suggests that it would have been obvious to have a stationary guide means. Therefore, Applicant respectfully requests the Office withdraw the rejection of Claim 1 and its dependent claims.

Conclusion

In view of the above remarks and amendments to the claims, Applicant believes that all pending claims in the present application are in condition for allowance. Finally, the absence of additional patentability arguments should not be construed as either a disclaimer of such arguments or that such arguments are not believed to be meritorious.

Respectfully Submitted,

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